

REMARKS

With respect to the rejection under 35 U.S.C. 112, first paragraph, Applicant disagrees that claims 4, 19, 33, 47 and 60 fail to comply with the written description requirement. "Color-changing" writing implements are well known to those of skill in the art, these simply being markers of the type wherein a color "magically" appears, or one color changes to another during the writing process. Submitted herewith is a download from Google, generated through the use of "color-changing" as the key word. The Examiner will see that the links generated correspond to the definition supplied herein. Applicant respectfully requests that the Examiner take official notice of this limitation. The same argument applies to the rejection of claims 4, 19, 33, 47 60 and 67 under 35 U.S.C. 112, second paragraph.

Claims 57-60, 62-64 and 68-71 stand rejected under 35 U.S.C. 112(b) over Kroop et al. Applicant respectfully disagrees. Anticipation may be established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Systems, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Moreover, anticipation requires the presence of all elements of a claimed invention as arranged in the claim, such that a disclosure "that 'almost' meets that standard does not 'anticipate'." Connell v. Sears, Roebuck Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

In this case, the independent claim of this group, claim 57, includes the limitations of a box having front, back and side panels defining two front and two back edges, and a pad of paper having a separate back panel hinged to one of these edges. Referring to Kroop et al., it is clear that what the Examiner is calling a "box" while it has back and side panels, it does not include a front panel. Indeed, this is the point of novelty of the Kroop invention, that the pads of paper be

folded onto the box, thereby forming a multi-layer "front panel" that otherwise did not exist. This is shown in all of the embodiments of the Kroop invention, including the triangular configuration of Figure 9, and the circular configuration of Figure 10. Given that the Kroop reference does not include a box with a front panel, anticipation has not been established, and all of the claims of this group should be deemed allowable.

Claims 1-4, 6-8, 11-22, 25-29 and 61 stand rejected under 35 U.S.C. 103(a) over Kroop et al. in view of Wilson ('976). Claim 1 has been amended to include some of the limitations of previously argued claim 57, namely, a box having front, back and side panels defined and two front edges and two back edges, by virtue of this amendment, even if the Kroop/Wilson combination were justified, which it is not from the prior art itself, Applicant's invention as now claimed would not result. Accordingly, *prima facie* obviousness has not been established.

Claims 9, 10, 23 and 24 stand rejected under 35 U.S.C. §103(a) over the references applied to claims 1 and 16, and further in view of Palmiter. These claims include the limitation of a handle on one or both of the box and the back panel of the pad. The Examiner concedes that Kroop et al. as modified by Wilson lacks this feature, but attempts to import the teachings of Palmiter to address the deficiency. However, in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to combine the cited references to arrive at Applicant's claimed invention. There must be something *in the prior art* that suggests the proposed combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to

combine prior-art references. In Re Dembeczak, 175 F.3d 994, 1000-01 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

In this case, there is no teaching or suggestion from the prior art to provide handles with through-holes as taught by Palmiter et al. to the Kroop et al. article and, indeed, it is impossible to ascertain where such handles would go. Given the invention of Kroop et al., and its point of novelty with multiple overlapping panels, it would be impossible to ascertain where such a handle would be placed on the structure and indeed, if a through-hole were formed, it might extend through the kit itself, thereby rendering the article unfit for its intended purpose. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The argument that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Claims 34 and 48 stand rejected under 35 U.S.C. 103(a) over the references applied to claim 30, and further in view of Wilson. These claims include the limitation of other materials, such as rubber stamps, ink pads, playing cards or flashcards, stickers or temporary tattoos. The Examiner argues that it would have been obvious to include such materials, "since such a modification would add greater versatility to the activity kit." Applicant respectfully disagrees, on the grounds that the underlying combination of references is without foundation, and there is no

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teaching or suggestion from the prior art to add these materials to any of the kits described in the cited prior art.

Claim 72 stands rejected under 35 U.S.C. 103(a) over Kroop et al. in view of Bauman. Claim 72 adds to claim 57 the limitation of a box with a closure flap. The Examiner concedes that Kroop is silent with respect to a closure flap, but argues that it could be combined with another reference such as Bauman to provide such a flap. Prima facie obviousness clearly has not been established in this case, since all of the wings 22, 24, 26, 28 of Kroop et al. *form a closure flap*, as discussed elsewhere hereinabove. As such, "such a modification would not positively secure the box to the activity kit," since the flaps are intended for that purpose, rendering an additional flap redundant and superfluous.

Claim 67 has been changed to correct a typographical error.

Based upon the foregoing amendments and comments, Applicant believes all claims are in condition for allowance. Questions regarding this application may be directed to the undersigned attorney at the telephone and facsimile numbers provided.

Respectfully submitted,

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Dated: May 25, 2005